

In the event that the Petitions Branch does not change their decision, Applicants also enclose a contingent Petition under 37 CFR § 1.78(a)(3) for the benefit of priority to the prior filed non-provisional and PCT applications.

**Applicants submit that the filing of a contingent Petition under 37 CFR § 1.78(a)(3) for the benefit of priority to the prior filed non-provisional and PCT applications has only been necessitated by the expected issuance of the patent, and should in no way be interpreted as an admission that a Petition is necessary.**

### **REMARKS**

The Official Communication of March 28, 2006 (hereinafter "Communication") states that the above-identified application was filed on December 12, 2001 and a Preliminary Amendment changing the priority data was filed on August 29, 2002. (Emphasis added).

Applicants thank the Petitions Attorney, Ms. Shirene Willis, for the telephone conference with Anna Barry regarding this issue on April 7, 2006. During the telephone conference, Ms. Willis stated that Applicants failed to meet the requirements of 37 CFR 1.78(a) because the priority information filed on December 12, 2001 did not include the "relationship" between the priority applications. Ms. Willis added that the relationships between the priority applications were not disclosed until the Preliminary Amendment filed on August 29, 2002, more than eight months after the filing date of the present application. Ms. Willis added that the relationship between the applications is whether the application is a continuation, divisional or continuation-in-part of the prior non-provisional application. The Communication and Ms. Willis request that Applicants file a Petition under 37 CFR 1.78(a)(3) accompanied by a fee and a statement that the delay between the date the claim was due under 37 CFR 1.78(a)(2) and the date the claim was filed was unintentional.

Applicants strongly disagree and respectfully submit that Applicants have fully complied with the requirements of 35 U.S.C. §120 and 37 CFR 1.78, and therefore a Petition is not necessary.

## **Facts**

Applicants filed a Preliminary Amendment on December 12, 2001 which states:

This is a continuation application claiming priority under 35 USC §120 to US serial number 09/946,374 filed 9/4/01 which claims priority under 35 USC §120 to US serial numbers: ... 09/403297, filed 10/18/99, now abandoned; ... which claims priority under 35 USC §120 to PCT international application numbers: ... PCT/US99/20111, filed 9/1/99; ... PCT/US/00/04342, filed 2/18/00 ... which claims priority under 35 USC §119 to US provisional application numbers: ... 60/101916, filed 9/24/1998[.]

Applicants filed a second Preliminary Amendment filed on August 29, 2002 which states:

This application is a continuation of, and claims priority under 35 USC §120 to, US Application 09/946374 filed 9/4/2001, which is a continuation of, and claims priority under 35 USC §120 to, PCT Application PCT/US00/04342 filed 2/18/2000, which is a continuation-in-part of, and claims priority under 35 USC §120 to, US Application 09/403,297 filed 10/18/1999, now abandoned, which is the National Stage filed under 35 USC §371 of PCT Application PCT/US99/20111 filed 9/1/1999, which claims priority under 35 USC §119 to US Provisional Application 60/101916 filed 9/24/1998.

The second Preliminary Amendment merely deleted the prior-filed applications that were not related to the invention specifically claimed in the present application.

## **Arguments**

First, Applicants note that the Patent Office is untimely in its rejection of Applicants claim to priority. The first Preliminary Amendment listing the priority documents was filed on December 12, 2001 and the subsequent Preliminary Amendment, deleting some of the priority claims, was filed on August 29, 2002. Applicants received a Filing Receipt dated July 24, 2002 which listed some of the claimed priority cases and indicated that the current application was a continuation application of 09/946,374. The Filing Receipt does not list US Application 09/403,297, but does claim priority to PCT Application PCT/US99/20111. Clearly the Patent Office recognized and accepted the priority claim to U.S. Application No.09/946,374 and to the PCT applications at that time, i.e. July 24, 2002. The Patent Office did not indicate that the

Preliminary Amendment of December 12, 2001 did not comply with any Patent Office requirements. It is inequitable for the Patent Office, at this late date of 2006, to determine that the claim to priority filed in 2001 was inadequate and requires a Petition for unintentionally delayed claim to priority.

Second, Applicants submit that the Patent Office was correct in the first instance in 2002 and that the first Preliminary Amendment filed December 12, 2001 does comply with all requirements for a proper claim to priority under the current laws and regulations.

The conditions under which a patent is entitled to the benefit of an earlier filing date in the United States are specified in 35 U.S.C. §120, which states:

An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States, or as provided by section 363 of this title, which is filed by an inventor or inventors named in the previously filed application shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application. No application shall be entitled to the benefit of an earlier filed application under this section unless an amendment containing the specific reference to the earlier filed application is submitted at such time during the pendency of the application as required by the Director. The Director may consider the failure to submit such an amendment within that time period as a waiver of any benefit under this section. The Director may establish procedures, including the payment of a surcharge, to accept an unintentionally delayed submission of an amendment under this section.

(Emphasis added).

Accordingly, under the patent statute, an application is entitled to the benefit of the filing date of the first application if it meets two requirements: the amendment filed with the application must contain a specific reference to the earlier filed application and the amendment must be filed within the time frame set by the Director. Applicants submit that first Preliminary Amendment filed on December 12, 2001 absolutely meets the requirements of 35 USC §120.

Section 35 USC §2, authorizes the USPTO to establish regulations, not inconsistent with law, for the conduct of proceedings in the USPTO. Section 35 USC §120 does not grant the

Director the right to impose his own definition of the term “reference” outside of the meaning set forth in the law.

In the *Federal Register* and in the Code of Federal Regulations the rules pertaining to patents are in Parts 1, 3, 4, 5, and 10 of Title 37, Patents, Trademarks, and Copyrights. In particular, 37 CFR 1.78 describes conditions under which an applicant may claim the benefit of an earlier filing date under 35 USC §120. Applicants note that 37 CFR 1.78(a)(2)(i) states:

(2)(i) Except for a continued prosecution application filed under §1.53(d), any nonprovisional application or international application designating the United States of America claiming the benefit of one or more prior-filed copending nonprovisional applications or international applications designating the United States of America must contain or be amended to contain a reference to each such prior-filed application, identifying it by application number (consisting of the series code and serial number) or international application number and international filing date and indicating the relationship of the applications. Cross references to other related applications may be made when appropriate (see §1.14).

(Emphasis added).

Therefore, 37 CFR 1.78 impermissibly expands the definition of the term “reference” to prior-filed applications to include application numbers and relationships between the prior-filed application(s). Applicants respectfully submit that 37 CFR 1.78 cannot legally change the scope of the law and broaden the requirements beyond what is required by 35 USC §120. The rules may only be established in accordance with the statutes. Accordingly, 37 CFR 1.78 cannot improperly add to the requirements set forth in 35 USC §120.

Nevertheless, Applicants respectfully submit that the Preliminary Amendment filed on December 12, 2001 meets the requirement of both 35 USC §120 and 37 CFR 1.78.

As the Communication correctly states, the first Preliminary Amendment claiming priority was filed with the present application on December 12, 2001. The first Preliminary Amendment included all prior-filed applications by serial number thus meeting the requirement to identify each priority application by application number. The first Preliminary Amendment also indicated that the claims for priority to the non-provisional and PCT applications was under

35 US.C. §120 thus meeting the requirement for an indication of the relationship of the applications.

The second Preliminary Amendment was filed on August 29, 2002. This amendment merely deleted from the priority claim those prior-filed applications that were not related to the invention specifically claimed in the present application.

Accordingly, Applicants submit that the first Preliminary Amendment filed on December 12, 2001 absolutely includes the relationships between the prior-filed applications since it clearly teaches that each application claims priority under 35 USC §120 or §119. As mentioned above, 35 USC §120 sets forth the statutory requirements for claiming the filing date of an earlier nonprovisional application. Therefore, Applicants' statement that an application claims priority under 35 USC §120 to the previously filed application by itself inherently describes a relationship between the two applications.

The Patent Office alleges that because the Preliminary Amendment filed on December 12, 2001 did not include the types of continuing application (i.e., continuation, divisional, or continuation-in-part application), that the Preliminary Amendment filed on December 12, 2001 did not comply with the requirements of 35 US §120 and 37 CFR 1.78.

Applicants strongly disagree. The Patent Office is applying an additional requirement which is not set forth in either the law or regulations implementing the applicable law.

As discussed above, under 35 USC §120, an application is entitled to the benefit of the filing date of the first application if an amendment containing a specific reference to the earlier filed application is filed within the required time frame. Again, the relevant portion of 35 USC §120 states, "No application shall be entitled to the benefit of an earlier filed application under this section unless an amendment containing the specific reference to the earlier filed application is submitted at such time during the pendency of the application as required by the Director." Section 37 CFR 1.78(a)(2)(i) states, "any nonprovisional application or international application ... must contain or be amended to contain a reference to each such prior-filed application, identifying it by application number (consisting of the series code and serial number) or international application number and international filing date and indicating the relationship of the applications."

Applicant's Preliminary Amendment filed on December 12, 2001 clearly states that the present application is a continuation application claiming priority under 35 USC §120 to US Application 09/496,374, which claims priority under 35 USC §120 to 09/403297, filed 10/18/99, which claims priority under 35 USC §120 to PCT international Applications PCT/US/00/04342 and PCT/US99/20111, filed 9/1/99, which claims priority under 35 USC §119 to US Provisional Application 60/101,916. Accordingly, the Preliminary Amendment filed on December 12, 2001 unequivocally contained the specific references to the earlier filed applications within the pendency of the application as required by the law and rules.

The Communication does not recite, but appears to rely upon MPEP §201.11 (III)(A) which requests additional information regarding the types of continuations from the applicant. The MPEP states, "The relationship between the applications is whether the instant application is a continuation, divisional, or continuation-in-part of the prior nonprovisional application." MPEP goes on to state, "Any benefit claim that does not both identify a prior application by its application number and specify a relationship between the applications will not be considered to contain a specific reference to a prior application as required by 35 U.S.C. 120." *Id.*

Applicants respectfully submit that the MPEP, as indicated by its title "The Manual of Patent Examining Procedure," is merely a set of guidelines for patent examiners, applicants, attorneys, agents who prosecute patent applications before the USPTO. In support, Applicants respectfully direct the Patent Office's attention to Foreword section of the MPEP, which clearly states:

This Manual is published to provide U.S. Patent and Trademark Office (USPTO) patent examiners, applicants, attorneys, agents, and representatives of applicants with a reference work on the practices and procedures relative to the prosecution of patent applications before the USPTO. It contains instructions to examiners, as well as other material in the nature of information and interpretation, and outlines the current procedures which the examiners are required or authorized to follow in appropriate cases in the normal examination of a patent application. **The Manual does not have the force of law or the force of the rules in Title 37 of the Code of Federal Regulations.**

(Emphasis added).

The Foreword section further states, “Examiners will be governed by the applicable statutes, rules, decisions, and orders and instructions issued by the Director of the USPTO and other officials authorized by the Director of the USPTO.”

In summary, Patent Office should be governed by the applicable statutes and rules. The MPEP should only be used as a guide in interpreting the statutes and rules. The MPEP cannot be used to impose additional requirements not stated in the statutes or rules.

Accordingly, Applicants respectfully submit that Applicants are not legally required to and the Patent Office cannot legally require Applicants to state the type of continuation of the prior-filed applications as requested in the MPEP. Although, a description of such type of continuation may be useful for patent reviewers, it is not a requirement of the patent statute or the patent rule.

Applicants submit that the Patent Office can only require Applicants to provide information as required by the statute (i.e., 35 USC §120) and rule (i.e., 37 CFR 1.78) issued by the Director of the USPTO.

Since Applicants have clearly provided a reference and a relationship between the prior-filed applications, as discussed above, Applicants have fully complied with the 35 USC §120 and 37 CFR 1.78 requirements.

Accordingly, Applicants respectfully submit that since the first Preliminary Amendment containing all the necessary information was filed on time, a Petition by Applicants under 37 C.F.R. 1.78(a)(3) to accept an unintentionally delayed claim for priority should not be required.

Nevertheless, in the event that the Petitions Branch does not agree with Applicants, Applicants also enclose a contingent Petition under 37 CFR § 1.78(a)(3) for the benefit of priority to the prior filed non-provisional and PCT applications.

As mentioned above, **Applicants submit that the filing of a contingent Petition under 37 CFR § 1.78(a)(3) for the benefit of priority to the prior filed non-provisional and PCT applications has only been necessitated by the expected issuance of the patent, and should in no way be interpreted as an admission that a Petition is necessary.**

Although no fees are believed to be due at this time, please charge any fees that might become applicable, including any fees for extension of time, or credit overpayment to Deposit Account No. 08-1641, referencing Attorney's Docket No. 39780-2830 P1C56. Please direct any calls in connection with this application to the undersigned at the number provided below.

Respectfully submitted,

Date: April 17, 2006

By:   
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